



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,803	03/12/1999	GREGORY M. GLENN	PM-256865	6258

7590 06/18/2002

NIXON & VANDERHYE PC  
1100 NORTH GLEBE ROAD  
8TH FLOOR  
ARLINGTON, VA 22201-4714

EXAMINER

EWOLDT, GERALD R

ART UNIT PAPER NUMBER

1644

DATE MAILED: 06/18/2002

28

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/266,803

Applicant(s)

Glenn et al.

Examiner

G.R. Ewoldt

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/14/02 and 3/01/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-107 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☒ Other: *Notice to Comply*

#### DETAILED ACTION

1. Note that new Claims 41-98 have been renumbered 50-107 under 37 CFR 1.126 as Claims 41-49 were canceled in the pre-amendment filed 3/12/99 and the claim numbers may not be reused.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-29, 31-61, 79-103, and 105-106, drawn to a method of inducing an immune response comprising applying a formulation comprising an adjuvant and a pathogenic antigen to skin, classified in Class 424, subclasses 204.1, 234.1, 265.1, 274.1, 278.1 and 283.1.

II. Claims 30, 62-77, 104, and 107, drawn to a method of inducing an immune response comprising applying an adjuvant to skin, classified in Class 424, subclass 278.1.

III. Claim 78, drawn to a method of inducing an immune response comprising separately applying an adjuvant and a pathogenic antigen to skin, classified in Class 424, subclasses 204.1, 234.1, 265.1, 274.1, 278.1 and 283.1.

The inventions are distinct, each from the other because:

3. Inventions I-III are different methods. These inventions act through different reagents, different process steps, with different modes of operation, different endpoints, and/or different outcomes. Note that the different method steps of Inventions I and III require that the inventions function through different mechanisms as the adjuvant in Invention III cannot be assisting the penetration of the antigen nor can it be supplying a depot effect as it would in Invention I. Therefore they are patentably distinct.

4. Because these inventions are distinct for the reasons given above and Groups I-III have acquired a separate status in the art as shown by their different classification and/or the searches are not co-extensive and because the Groups encompass divergent subject matter, restriction for examination purposes as indicated is proper.

5. Regardless of whichever Group Applicant elects, Applicant is further required under 35 U.S.C. § 121 to elect a **specific** adjuvant and list all claims reading thereon. Currently Claims 1-21, 27-68, 74-84, 90-91, 93-107 are generic.

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The different adjuvants, such as cytokines or LPS, or the different ADP-ribosylating agent,, have significantly different chemical structures and function through different mechanisms. Therefore, the species are independent and patentable over one another.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Serial No. 09/266,803  
Art Unit 1644

4

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

A handwritten signature in black ink, appearing to read "G.R. Ewoldt". The signature is stylized with a large, looped initial "G" and a cursive "Ewoldt".

G.R. Ewoldt, Ph.D.  
Patent Examiner  
Technology Center 1600  
June 13, 2002